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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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33425 7590 03/17/2008 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				
EXAMINER STANLEY, JANE L				
ART UNIT		PAPER NUMBER		
4145				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,946

Applicant(s)

HABASSI ET AL.

Examiner

JANE L. STANLEY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 20070305
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains legal phraseology and is greater than one paragraph in length. Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

3. **Claims 5-25** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim depend(s) from other multiple dependent claims. See MPEP § 608.01(n). Accordingly, the **claims 5-25** have not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the instance of **claim 1**, the claim recites the broad recitation "more than 50% by weight", and the claim also recites "preferably more than 60% by weight", "more preferably more than 70% by weight" and "most preferably more than 80% by weight" which are the narrower statements of the range/limitation.

In the instance of **claim 2**, the claim recites the broad recitation "from 0.1 to 20% by weight", and the claim also recites "preferably from 1 to 10% by weight", and "more

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preferably from 2 to 10% by weight" which are the narrower statements of the range/limitation.

In the instance of **claim 3**, the claim recites the broad recitation "an integer from 0 to 5" and the claim also recites "preferably 0 or 1" which is the narrower statement of the range/limitation.

In the instance of **claim 4**, the claim recites the broad recitation "a HLB ranging from 9 to 14" and the claim also recites "preferably from 10 to 13" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1 and 4** are rejected under 35 U.S.C. 102(b) as being anticipated by Gaul *et al.* (US 5,413,729).

Regarding claim 1, Gaul *et al.* teaches a cleaning solution characterized in that it comprises, based on the total weight of the solution: (A) more than 50% by weight, of at least one lactone (90 wt% γ -butyrolactone, col 8, Table 4, Ex. 28; from about 90 to about 10 percent by weight lactone, col 5, ln 4-5); and (B) at least one surfactant compound having a HLB ranging from 8 to 15 (non-ionic surfactants with HLB of about 10, col 4 ln 46-51).

Regarding claim 4, modified Gaul *et al.* teaches the claim limitations as set forth above and Gaul *et al.* further teaches a cleaning solution characterized in that surfactant B has a HLB ranging from 9 to 14 (non-ionic surfactants with HLB of about 10, col 4 In 46-51).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaul *et al.* (US 5,413,729) as applied to claim **1** above, and in view of GB 2 172 304 A (hereinafter referred to as GB'304).

Regarding claim 2, Gaul *et al.* teaches the claim limitations as set forth above. While Gaul *et al.* teaches a cleaning solution comprising aromatic hydrocarbons (Col 4, In 3-21) and organic solvents (i.e. alcohols, col 4, In 23-26), not taught is the cleaning solution characterized in that it further comprises, based on the total weight of the solution: (C) from 0.1 to 20% by weight of at least one benzyl alcohol, either substituted or not.

However, GB'304 teaches a cleansing composition (pg 1, In 1-7) comprising 10-50% by weight of a lactone (pg 1, In 36; and pg 1, In 44-51) and 5-95% by weight benzyl alcohol (organic solvents, pg 1, In 54-61 and pg 2, In 1-3).

Gaul *et al.* and GB'304 are combinable because they are concerned with the same field of endeavor, namely surface-stripping compositions that clean deposits from said surfaces using lactones. At the time of the invention, a person having ordinary skill in the art would have found it obvious to use benzyl alcohol, as taught by GB'304, in the cleaning composition as taught by Gaul *et al.*, and would have been motivated to do so

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to adjust the evaporation rate of the composition or to reduce the cost of the composition (Gaul *et al.*, col 4, ln 6).

Regarding claim 3, modified Gaul teaches the claim limitations as set forth above and GB'304 further teaches a cleaning composition characterized in that the component C has the formula: (see instant claim 3 for formula) wherein: n denotes an integer from 0 to 5, preferably 0 or 1; R' denotes an alkyl group, preferably having from 1 to 5 carbon atoms; or R' denotes an alkoxy group -[O-Z]-n'H, wherein Z denotes a divalent alkyl group, preferably having from 2 to 4 carbon atoms; n' is an integer from 0 to 10 (in the case where n=0 the formula of component C is identical to benzyl alcohol which is taught by GB'304, pg 1, ln 54-61).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE L. STANLEY whose telephone number is (571)270-3870. The examiner can normally be reached on Monday - Friday, 7:30 am - 5:00pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571) 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gwendolyn Blackwell/
Primary Examiner, Art Unit 1794

JLS